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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,559	03/02/2001	Reinhard Plaschka	JEK/PILASCHKA	3460

7590

09/10/2002

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

9

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/719,559

Applicant(s)

PLASCHKA ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed June 27, 2002.
Claim 1-17 were canceled and new claims 18-34 were added rendering claims 18-34 pending.

Claim Rejections - 35 USC 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. The term "high" in claim 20 is a relative term which renders the claim indefinite.
The term "high" is not defined by the claim as to a requisite degree.

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18-19, 21-23 and 26-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards (U.S. 5,388,862).

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6. Edwards discloses a security article such as a banknote or identity card (abstract) having printed thereon a design, lettering or pattern comprising printed characters (column 1, lines 30-31) which conventionally consist of special effect print that is not readily visible without a vision aid as taught in column 1, lines 35-37.

Edwards discloses security paper with a light-transmitting coating bonded to a second [coating (column 3, lines 4-9)] being luminescent, providing mechanical protection where the coatings provide adhesive properties to bond the security element into paper (column 4, lines 57-59). Edwards discloses the security paper comprising thread (column 6, lines 38-41). Although Edwards does not explicitly disclose a coating weight, coating weight is optimizable. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering an optimum or workable range is of routine skill in the art. Edwards does not disclose the paper layer produced in a paper machine. It would have been obvious to one of ordinary skill in the art to make the paper in a paper machine because this is a well-known process within the art.

Claim Rejections – 35 USC § 103(a)

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards (U.S. 5,388,862) in view of Detrick et al. (U.S. 5,161,829).

8. Edwards is relied upon for claims 18-19, 21-23 and 26-34. Edwards does not disclose the security paper consisting of cotton fibers. Detrick teaches security paper formed of cotton fiber (column 3, lines 57-60). Edwards and Detrick are analogous art because they are from the same field of security paper. It would have been obvious to

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one ordinary skill in the art to include the cotton fiber in the security paper of Edwards .
because Detrick teaches this component produces improved printability and feel of the
security paper.

Claim Rejections – 35 USC § 103(a)

9. Claim 20 and 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards (U.S. 5,388,862) in view of Howland et al. (U.S. 6,063,239).

10. Edwards is relied upon for claims 1-2, 4-6 and 9-17. Edwards does not disclose the security paper consisting of polyamide fibers. Howland teaches security paper (abstract) comprising polyamide fibers (column 1, lines 49-50) wherein the adhesive of the security paper consists of acrylics and acrylamide interpolymers (claim 21).

Edwards and Howland are analogous art because they are from the same field of security paper. It would have been obvious to one ordinary skill in the art to include the polyamide fiber in the security paper of Edwards because Howland teaches the polyamide fiber improves durability of the security paper.

Response to Arguments

11. Arguments made in regards to rejection made under 35 USC 112, second paragraph have overcome the rejection due to cancellation of the original claims 1-17.

Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Edwards (U.S. 5,388,862) have been considered but are

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unpersuasive. Applicant argues the security paper of the claimed invention differs from the security element of Edwards and the reference describes coating the security element so that it bonds to the security paper where the paper is not coated itself. Applicant argues nowhere is there a disclosure or suggestion in Edwards of actually coating the security paper itself as in the claimed invention. Applicant argues a coating for security paper requires optimal properties relating to sound, color and fitness for circulation not required for a security element. This is not true because Applicant claims a security paper comprising a surface coating disposed on at least one surface of said security paper; wherein said coating comprises a binder and lacks a filler substance and polyurethane. Edwards discloses a security paper including a security element having a support layer provided with a coating (column 3, lines 4-9) wherein the coatings provide adhesive properties to bond the security element to the paper (column 4, lines 57-59), as disclosed in the previous rejection. The coating of the security element, which is a part of the security sheet is on the surface of the security paper. Additionally, the *optical* properties of the security paper is not relevant because these *inherent* properties have not been included in Applicant's claimed invention. Applicant further argues the thread of Edwards cannot possibly be confused as the security paper recited in the claimed invention. Paper is essentially a woven sheet, which is composed of threads.

Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Edwards (U.S. 5,388,862) in view of Howland (U.S. 5,868,902) has been overcome due to the secondary reference teaching away from the invention with the teaching of polyurethane in the supplemental reference.

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Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Edwards (U.S. 5,388,862) in view of Detrick (U.S. 5,161,829) has been considered but is unpersuasive. Applicant argues Detrick fails to make up for the shortcomings of Edwards, namely Detrick does not disclose or suggest a security paper having a coating having a surface coating disposed on at least one surface of the security paper wherein the coating comprises a binder lack a filler substance and polyurethane. Applicant has pointed out that the Edwards in view of Detrick should be withdrawn because Detrick cannot overcome the deficiencies of Edwards since the rejections are based on Edwards. Since the primary Edwards reference rejection has been maintained, the rejection made under 35 USC 103(a) as being unpatentable over Edwards (U.S. 5,388,862) in view of Detrick (U.S. 5,161,829) is also maintained for reasons of record, being that both reference are analogous art directed towards security paper.

Arguments made in regards to rejection made under 35 USC 103(a) as being unpatentable over Edwards (U.S. 5,388,862) in view of Howland et al (U.S. 6,023,239) has been considered but is unpersuasive. Applicant argues Howland '239 fails to make up for the shortcomings of Edwards, namely Howland '239 does not disclose or suggest a security paper having a coating having a surface coating disposed on at least one surface of the security paper wherein the coating comprises a binder lacks a filler substance and polyurethane. Applicant has pointed out that the Edwards in view of Howland '239 should be withdrawn because Howland cannot overcome the deficiencies of Edwards since the rejections are based on Edwards. Neither reference discloses or

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suggests the use of a binder containing a filler substance or polyurethane, meeting the limitation of claim 25. Because Edwards has been maintained, the rejection made under 35 USC 103(a) as being unpatentable over Edwards (U.S. 5,388,862) in view of Howland et al (U.S. 6,023,239) is also maintained for reasons of record, being that both reference are analogous art directed towards security paper.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the

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examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

